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No. 06-1003

(Serial No. 09/449,237)

United States Court of Appeals
for the
Federal Circuit

IN RE JAMES PRESCOTT CURRY

Appeal from the United States Patent and Trademark Office,
Board of Patent Appeals and Interferences.

BRIEF FOR APPELLANT

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DECEMBER 5, 2005

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

In re Curry

v.

No. No. 06-1003

CERTIFICATE OF INTEREST

Counsel for the (petitioner) (appellant) (respondent) (appellee) (amicus) (name of party)

Appellant

certifies the following (use "None" if applicable; use extra sheets if necessary):

1. The full name of every party or amicus represented by me is:

James Prescott Curry

2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is:

James Prescott Curry

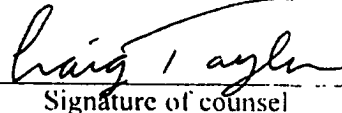
3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are:

4. ☒ There is no such corporation as listed in paragraph 3.

5. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court are:

Craig Taylor Law Office, PLLC; Craig F. TaylorCasimir F. Laska, Michael Best & Friedrich LLP (only initial patent preparation and prosecution before the USPTO)Dec. 2, 2005

Date



Signature of counsel

Craig F. Taylor

Printed name of counsel

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STATEMENT OF RELATED CASES

No appeal in or from the decision appealed herein was previously before this Court or any other court. This appeal is related to U.S. Patent Application No. 09/449,237, having claims not on appeal pending in the United States Patent and Trademark Office (hereinafter the "PTO").

STATEMENT OF SUBJECT MATTER AND JURISDICTION

This appeal is brought pursuant to 35 U.S.C. § 141 from a decision of the Board of Patent Appeals and Interferences ("the BPAI") of the U. S. Patent and Trademark Office [A1]. The notice of appeal from the BPAI's decision dated June 30, 2005 was timely filed in accordance with 35 U.S.C. § 142. This Court has jurisdiction over this appeal pursuant to 28 U.S.C. § 1295(a) (4) and has jurisdiction pursuant to 28 USC 1651 to issue all writs necessary to aid in its jurisdiction.

STATEMENT OF THE ISSUES

I. Whether the BPAI erred in rejecting claims 81, 82, 85 and 93 as obvious under 35 U.S.C. § 103, by giving several claim limitations no patentable weight, where the limitations were non-technical and business related. This issue turns on the sub-issues below:

A. Whether the BPAI erred in giving the database fitness or wellness contents no patentable weight in the claims.

B. Whether the BPAI erred in giving the fitness center computer portal locations no patentable weight in the claims.

C. Whether the BPAI erred in giving the fitness center portal sponsorship no patentable weight in the claims.

D. Whether the BPAI's giving no patentable weight to the fitness database contents, the fitness center portal locations, and the fitness center portal sponsorship, applied a "technical effect" test, reading non-technical, business method limitations out of the claims, thereby allowing the rejection of business method patent claims using 35 U.S.C. § 103 rather than 35 U.S.C. § 101,

circumventing this Court's holding in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*

E. Whether the non-technical, business related limitations should be given patentable weight.

STATEMENT OF THE CASE

Appellant James Prescott Curry appeals from a decision on Appeal No. 2005-0509 of the Board of Patent Appeals and Interferences (the "BPAI") in a proceeding that sustained a final rejection of method claims 81, 82, 85, and 93 in U.S. Patent Application No. 09/449,237 as unpatentable under 35 U.S.C. § 103.

STATEMENT OF THE FACTS

A. Summary of the Invention

The invention is described in U.S. Patent Publication No.2002-0059359A1 [A126]. Physical fitness and wellness are worthy, if elusive goals, and any assistance provided by modern technology is welcomed. Keeping track of workout routines and the progress made in those routines could be better served by improved use of modern technology.

The present invention provides methods and systems allowing a person to record wellness related data generally, and physical fitness data specifically, at the location most conveniently and closely located to the workout and weighing activities, specifically at the physical fitness center loci. The invention provides a system and methods allowing workout activity to be recorded at a computer terminal or kiosk synergistically located at a related location, i.e., a physical fitness center. The invention allows the user to later retrieve this stored information at another location, for example their home, over the Internet, to assess progress and anomalies with the perspective of rest and privacy.

Invention methods provide an economic driving force for an organization to provide data entry terminals or kiosks for entering physical fitness data, located in a fitness center and coupled to the Internet. One method allows a central service provider to distinguish between terminals that are sponsored by and located at a fitness center, from those terminals not so sponsored and co-located. This may allow directing the sponsored terminal user toward buying products in the shop of that particular fitness center, or toward value added lessons or services provided by that particular fitness center. Non-sponsored terminals, for example, a home Internet connected computer, might not receive such directed advertising and prompting.

B. Procedural History

U.S. Patent Application No. 09/449,237 was written and filed by other counsel on Nov. 24, 1999, claiming priority to U.S. Provisional Patent Application No. 60/118,262, filed Feb 2, 1999. The Examiner ultimately rejected all pending claims on Oct. 8, 2002 under 35 U.S.C. § 103 in a Final Office Action [A25]. A Notice of Appeal, Appeal Brief, Examiner's Answer, and Reply Brief were all timely filed with the PTO. The BPAI issued a Decision on Appeal on June 30, 2005. The BPAI did not sustain the Examiner's rejections on claims 83-84, 86-92, and 95-97. The claims not sustained include limitations related to automatically assigning users to groups as a function of user attributes, and are not on appeal. The BPAI did sustain the Examiner's rejection of independent claims 81, 85, and 93, and claim 82 dependent from claim 81.

C. The Representative Claims

Three claim sets remain on appeal, including independent claims 81, 85, and 95, and claim 82 dependent from claim 81 [A22]. All claims are method claims. A claim chart of the independent claims was before the BPAI, with a truncated version included in the present appendix [A16]. Three claim limitations, in varying forms, are at issue. The BPAI summarized the three limitations in the Decision on Appeal [A7, first full paragraph]. Appellant has discussed the varying

forms of the three limitations as three limitations: one as a wellness related database and/or fitness related data; another as the sponsored or non-sponsored portal; and yet another as the fitness center location of the portal.

Claim 81 recites a method of providing wellness-related services, including at least one of wellness, health, or fitness services through a publicly accessible distributed network to authorized users using authorized portals. Claim 81 recites the limitations: wellness-related databases; sponsored and non-sponsored computer portals; and portals located at a fitness center [A22]. Claim 82 depends from claim 81 and recites fitness related data [A22-23].

Claim 85 recites a method of providing wellness-related services, including at least one of wellness, health, or fitness services through a publicly accessible distributed network to authorized users using authorized portals. This claim recites the limitations: wellness-related databases; sponsored and a non-sponsored portals; portals located at a fitness center; and fitness-related data selected from the group consisting of workout plans, workout goals, weight training plans, weight training weights and weight training repetitions [A23].

Claim 93 recites a method of providing wellness-related services, including at least one of wellness, health, or fitness services through a distributed communications network, wherein the network is coupled to an on-line wellness

related site and to a plurality of sponsored portals located at fitness centers and non-sponsored portals [A23-24].

D. The Prior Art

U.S. Patent No. 5,678,041 (Baker et al.) (hereinafter "Baker") [A100].

U.S. Patent No. 5,954,640 (Szabo) (hereinafter "Szabo") [A112].

There is little or no disagreement on what the prior art teaches.

E. The Examiner's Position

The Examiner's final rejection is included in the Appendix [A25-41], including a concise, well written Response to Arguments portion [A37-39], similar to the BPAI's position.

F. The BPAI's Decision

The BPAI's Decision on Appeal issued June 30, 2005 [A1]. The BPAI reversed the Examiner's rejection of claims 83-84, 86-92, and 95-97 under 35 U.S.C. § 103. The BPAI affirmed the Examiner's rejection of claims 81, 82, 85, and 93 under 35 U.S.C. § 103 [A4]. The BPAI grouped the four claims into three groups, with Group I including both claim 81 and 93, Group II including claim dependent 82, and Group III including claim 85 [A5].

Claims 81 and 93, in Group I, had been rejected by the Examiner under 35 U.S.C. § 103 as obvious over Baker in view of Szabo. The BPAI lists the three claim limitations at issue with respect to claim 81 [A7, first full paragraph]. The BPAI discussed the "wellness related" data in the database and decided it did "not functionally change either the data storage system or communication used ..."

[A7]. *In re Ngai* 367 F.3d 1336 (Fed. Cir. 2004) and *In re Gulak* 703 F.2d 1381 (Fed. Cir. 1983) were cited for the proposition that nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious.

The BPAI gave three examples of nonfunctional descriptive material, two article or apparatus related and one process related. The BPAI's first example was a computer readable storage medium which differs from the prior art only in the music or literary work stored on the medium. The second example was a computer that differs from the prior art solely with respect to descriptive material which does not reconfigure the computer. The third example was a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention [A8]. The BPAI held that the difference between the prior art and Appellant's claimed invention (the database contents) is simply a rearrangement of nonfunctional descriptive material [A8].

The fitness center location of the portal was held to be "merely a field of use limitation" [A8-9], later more properly termed a "statement of intended use", the phrase Appellant uses herein. The BPAI stated the fitness center does not differ *structurally* from the school of the *Baker* reference (emphasis added) [A8]. The BPAI further stated that a fitness center and shopping mall were the same *structurally* (emphasis added). Finally the BPAI held that statements of intended use do not serve to distinguish *structure* over the prior art, citing *In re Pearson* 494 F.2d 1399 (CCPA 1974), *In re Yanush* 477 F.2d 958 (CCPA 1973), and *In re Casey* 370 F.2d 576 (CCPA 1967) (emphasis added) [A9].

The portal sponsorship of the portal limitation was discussed and Baker was found to teach differing access rights based on location data including portal addresses [A9]. The BPAI found that "labeling of the portal as sponsored or unsponsored does nothing to change the *structure* of the portal", rendering this "non-functional descriptive material" (emphasis added) [A9].

The BPAI then addressed Claim 82, referring to their claim 81 analysis. Claim 82 is a dependent claim which further recites fitness related data. The BPAI held this "does not functionally change either the data storage system or communication system used in the method." The Examiner's final rejection of Claim 82 was sustained [A10].

Claim 85 was analyzed, and their Claim 81 analysis referred to once more. The BPAI sustained the Examiner's final rejection of Claim 85 under 35 U.S.C. § 103.

The BPAI nowhere held that the database fitness contents, the fitness center portal location, or the fitness center portal sponsorship were taught or suggested by the prior art [A1-41]. Rather, these limitations were given no patentable weight.

SUMMARY OF ARGUMENT

Appellant believes there is substantial agreement between Appellant and the PTO that: not all limitations are found in the prior art; the recited methods may be implemented using non-novel computer hardware and network technology; and the claims are not patentable over the prior art if all of the non-technical limitations are given no patentable weight. Disagreement remains over the patentable weight to be given non-technical limitations in the method claim steps.

The BPAI was in error deciding that the wellness related database, fitness related data, and fitness related data selected from the group consisting of workout plans, workout goals, weight training plans, weight training weights, and weight training repetitions was non-functional descriptive material in the steps of the method claims.

The BPAI improperly cited *Ngai*, as the *Ngai* method claims *were* patentable, only the printed method included in the kit claim was at issue. The PTO effectively argues that the lack of novelty in the system precludes patentability of a *new use* of that system recited in method claims, not supported in *Ngai*.

The BPAI erred in citing *Gulak*. This Court held the *Gulak* apparatus claims *were* patentable as there was a functional relationship between the printed matter and the underlying substrate of a recreational ring having digits in unique positions relative to other digits on the ring. Appellant is arguing for patentability of method claims, not the printed matter article claims as in *Gulak*.

The BPAI erred in deciding the physical location of the portals in a fitness center was an intended use. The use is explicitly recited in the *method* claim steps, not the intended use of a claimed apparatus lacking structural novelty over prior art structure. One utility of the invention is being able to enter workout data at a fitness center to view it at home. Entering the fitness related data at portal located in a fitness center *is how* the process steps are performed to achieve one *utility* of the invention.

The BPAI stated that statements of intended use do not serve to distinguish *structure* over the prior art, citing *Pearson*, *Yanush*, and *Casey* (emphasis added) [A9]. Appellant finds no support for the PTO in these cases. In *Pearson*, the CCPA

held that terms setting forth an intended use, or a property inherent in an otherwise old composition, did not differentiate the claimed composition from the prior art. *Pearson* is not relevant as the claims presently at issue are not composition claims and no argument of inherently disclosed prior art elements has been made.

In *Yanush*, the CCPA held that a “*use limitation* does not impart a *structural* feature different from the prior art” (emphasis added). The limitations at issue here are *method* limitations in *method* claims, not the intended use of structure in apparatus claims. In *Casey*, the CCPA held that the claimed structure differed in no way from the prior art and that the method in which a machine is to be used is not germane to the patentability of the machine itself. Appellant Curry’s limitations are limitations on method steps in method claims, not elements of apparatus claims.

The BPAI erred in giving the fitness center portal sponsorship no patentable weight. The BPAI's reasoning was in error for several reasons. First, the sponsorship of a portal in a fitness center and the location of the portal in the fitness center are clearly limitations, as a portal not being so sponsored and located would not literally infringe a claim containing this language. Second, the sponsorship of a portal by a fitness center and the location of the portal in the fitness center are commercially functionally related to each other, as the fitness center is more likely to pay for a portal located in the center. Third, the content of

the database is functionally related to the steps, as the content of the wellness related data is likely to be generated at the fitness center.

The BPAI's giving no patentable weight to the fitness database contents, the fitness center portal locations, and the fitness center portal sponsorship, applied a "technical effect" test, reading non-technical, business method limitations out of the claims, thereby allowing the rejection of business method patent claims using 35 U.S.C. § 103 rather than 35 U.S.C. § 101, circumventing this Court's holding in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 139 F.3d 1368 (Fed. Cir. 1998). In *State Street*, this Court stated that "Since the 1952 Patent Act, business methods have been, and should have been, subject to the same legal requirements for patentability as applied to any other process or method" (*Id* at 1375). If the BPAI is allowed to prevail over Appellant Curry, then claims such as the claim validated by this Court in *State Street* could easily be invalidated by giving the non-technical business related limitations no patentable weight.

ARGUMENT

I. STANDARD OF REVIEW

This court reviews the BPAI panel's underlying factual findings for substantial evidence and the BPAI panel's ultimate determination of obviousness without deference. *Cf In re Watts*, 354 F.3d 1362, 1365 (Fed. Cir. 2004); and *In re Gartside*, 203 F.3d 1305, 1315 (Fed. Cir. 2000).

This court reviews BPAI panel procedural actions under the arbitrary, capricious, abuse of discretion, or otherwise not in accordance with law standard specified in the Administrative Procedures Act, 5 USC 706. *Dickinson v. Zurko*, 527 U.S. 150, 154 (1999). This Court upholds the BPAI's interpretation of USPTO regulations unless that interpretation is plainly erroneous or inconsistent with the regulation. *Auer v. Robbins*, 519 U.S. 452, 461-62 (1997), and *Bowles v. Seminole Rock & Sand Co.*, 325 U.S. 410, 414 (1945).

II. THE CLAIMED INVENTION

The claimed invention is recited in claims 91, 82, 85 and 93 [A22-24]. The claims on appeal relate to computer implemented methods allowing the entry of wellness related data, for example fitness workout data, in data entry portals or kiosks located in fitness centers followed by viewing the data over the Internet at other locations. Some fitness center portals are sponsored by businesses which may vary delivered content as a function of the sponsored status of the portal. In one example, sponsored portals may be sent content promoting fitness center activity, while non-sponsored, home based portals may not see such content. The present patent application, written and filed by prior counsel, claims priority to Feb. 2, 1999, well over five years ago [A126].

Three claim sets, consisting of independent claims 81, 85, and 93, and claim 82 dependent from claim 81, remain on appeal. All claims are method claims,

reproduced in the Appendix [A22] as are claim charts of the independent claims on appeal [A16]. A longer version of this claim chart was before the BPAI.

III. PRELIMINARY STATEMENT REGARDING APPARENT AGREEMENT

Appellant believes there is substantial agreement between Appellant and the PTO, focusing the issues. The Examiner has stated that not all limitations are found in the prior art [A29-30], not contradicted by the BPAI. Appellant has stated that the recited methods may be implemented using non-novel computer hardware and network technology, and stipulates that the claims on appeal are not patentable over Baker and Szabo if all three non-technical limitations at issue are all given no patentable weight. Disagreement remains over the patentable weight to be given non-technical limitations in the method claim steps.

IV. THE BPAI ERRED IN THE DECISION ON APPEAL

A. The BPAI erred in giving the database fitness and wellness contents no patentable weight in claims 81, 82, 85 and 93.

The BPAI was in error deciding that the wellness related database, fitness related data, and fitness related data selected from the group consisting of workout plans, workout goals, weight training plans, weight training weights, and weight training repetitions was non-functional descriptive material in the steps of the method claims.

The BPAI decided that the wellness related database does not functionally change either the data storage system or the communication system used in the method of claim 81 [A7]. Appellant agrees that non-novel data base systems and computer communication systems can be used to implement the recited invention. The BPAI used tautology as analysis, stating non-functional descriptive material cannot render non-obvious an invention that would have otherwise been obvious. Appellant agrees. However, labeling non-technical limitations not found in the prior art as non-functional descriptive material should not make obvious a non-obvious invention.

The BPAI erred in citing *Ngai* 367 F.3d 1336 (Fed. Cir. 2004) to support their position. *Ngai* had invented a new method, recited in *allowed method claims*,

and also recited as a printed matter limitation in a kit claim, which was not allowed. In *Ngai*, this court stated “[T]he PTO argues that Ngai’s claim merely teaches a new use for an existing product. Thus, according to the PTO, Ngai claims the new use as a method, but he cannot claim the existing product itself.” (*Id.* at 138). The Court went on to find the kit claim unpatentable.

Here, the PTO argues for non-patentability of *method* claims, citing *Ngai*. The Ngai method claims *were* patentable, only the printed version of the method included in the kit claim was at issue. Specifically, the PTO here argues appellant's method claim “does not functionally change either the data system or the communication system used in the method of claim 81” [A7]. The PTO effectively argues that the lack of novelty in the system precludes patentability of a *new use* of that system recited in method claims. Appellant finds no support for the PTO’s position in *Ngai*.

The patentability of methods using non-novel apparatus is well settled. “That a process may be patentable, irrespective of the particular form of the instrumentalities used cannot be disputed. ... The machinery ... may or may not be new or patentable; whilst the process itself may be altogether new and produce an entirely new result.” *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

The BPAI erred in citing *Gulak* 703 F.2d. 1381 (Fed. Cir. 1983) to support their position. This Court held the *Gulak* apparatus claims were patentable as

there was a functional relationship between the printed matter and the underlying substrate of a recreational ring having digits in unique positions relative to other digits on the ring. Appellant is arguing for patentability of method claims, not the article claims as at issue in *Gulak*. The BPAI's reliance on *Gulak* might be relevant, were Appellant arguing for patentability of an article having the claim 81 method printed thereon. Appellant is not.

B. BPAI erred in giving the fitness center computer portal locations no patentable weight in claims 81, 82, 85 and 93.

The BPAI held the physical location of the portals in a fitness center was an intended use. Appellant disagrees. The use is explicitly recited in the claim steps, not the intended use of an apparatus lacking novelty over prior art structure.

The BPAI found the fitness center did not differ structurally from the school of Baker [A8]. Appellant agrees that if the claims were apparatus claims directed to building structure, for example trusses, then the intended use should be given no patentable weight. Applicant disagrees with the BPAI, in that a novel collection of steps should be given patentable weight in method claims, even utilizing non-novel apparatus.

The BPAI gave three examples of situations involving nonfunctional descriptive material including two apparatus examples and the following process example: “-a process that differs from the prior art only with respect to

nonfunctional descriptive material that cannot alter *how* the process steps are to be performed to achieve the *utility* of the invention” (emphasis added) [A8].

Appellant agrees. In various claims the method steps include: placing in communication an online cite having wellness related databases with a sponsored portal located at a fitness center (claims 81 and 85); receiving and responding to a request from the sponsored portal (claims 81 and 93); obtaining fitness related data from a user through the sponsored portal at the fitness center (claims 82, 85 and 93); and providing access to the entered data from a non-sponsored portal over the Internet (all claims, either explicitly or inherently). One utility of the invention is being able to enter workout data at a fitness center to view it at home. Entering the fitness related data at portal located in a fitness center *is how* the process steps are performed to achieve one *utility* of the invention.

The BPAI stated that statements of intended use do not serve to distinguish *structure* over the prior art (emphasis added) [A9]. The BPAI cited *Pearson*, *Yanush*, and *Casey*.

The BPAI erred in relying on *Pearson* 494 F.2d 1399 (CCPA 1974). The CCPA held in *Pearson* that terms setting forth an intended use, or a property inherent in an otherwise old composition, did not differentiate the claimed composition from the prior art (*Id.* at 1403). The *Pearson* court also affirmed in part and reversed in part the BPAI's inherency based obviousness rejection for the

method claims (*Id.* at 1403-04). *Pearson* is not relevant to the present case, as the claims presently at issue are not composition claims and no argument of inherently disclosed prior art elements has been made.

The BPAI erred in relying on *Yanush* 477 F.2d 958 (CCPA 1973). The CCPA held in *Yanush* that a “*use limitation* does not impart a *structural* feature different from the prior art” (emphasis added) (*Id.* at 959). The *Yanush* court further held that this “is a *process limitation* which does not limit or define the claimed *apparatus*.” (emphasis added) (*Id.*). Appellant repeats that the limitations at issue are method limitations in method claims, not the intended use of structure in apparatus claims. Appellant seeks allowance of *method* claims. *Yanush* is not on point.

The BPAI erred in relying on *Casey* 370 F.2d 576 (CCPA 1967). In *Casey*, the CCPA held that the claimed structure differed in no way from the prior art disclosure and that the method in which a machine is to be used is not germane to the patentability of the machine itself (*Id.* at 579-80). The court cited with approval the PTO’s view that the concept related to a method, rather than an apparatus, and that the invention recited “are *method* steps, and cannot confer patentability on an *apparatus claim* (emphasis added) (*Id.* at 580). Appellant Curry’s limitations are limitations on method steps in method claims, not elements of apparatus claims. The BPAI’s position finds no support in *Casey*.

Appellant urges this Court to find that method of use limitations are proper limitations in method of use claims.

C. The BPAI erred in giving the fitness center portal sponsorship no patentable weight in claims 81, 82, 85 and 93.

The claims also recite a limitation of the portal being sponsored by a fitness center, with the content delivered to the portal varying as function of whether the portal was sponsored. This limitations is not technical in nature, but is related to business methods. Appellant agrees that delivering content to the portals as a function of the portal sponsorship could be performed using existing devices, such as computers and networking technology. The BPAI's reasoning was in error for several reasons.

First, in a business context, the sponsorship of a portal in a fitness center and the location of the portal in the fitness center are clearly limitations, as a portal not being so sponsored and located would not literally infringe a claim containing this language. The words clearly limit the claim. The notice function of the patent is well served.

Second, in a business context, the sponsorship of a portal in a fitness center and the location of the portal in the fitness center are clearly functionally related to each other, as the fitness center is more likely to pay for a portal located in the center, where there are members, and where there are workout facilities to generate

data to enter into the portal. A fitness center is also more likely to pay for a portal to inform a member about revenue generating activities and products available at the fitness center. An unrelated party is less likely to sponsor a portal to sell products for, or provide information about, the fitness center. Thus the "placing in communication" step, the "processing step", and the "responding" step of claim 81 are indeed functionally related to the location and sponsorship of the portal.

Third, the content of the database is functionally related to the steps, as the content of the wellness related data is likely to be generated at the fitness center. For example, providing a portal for entry of workout or weight information makes perfect sense at a fitness center, where such data is generated, and makes no sense at the library location cited by the Examiner. If there was no functional relationship, then entering workout data at a library would make as much sense as at a fitness center.

The portal users in a fitness center are targeted, segmented users functionally related to the wellness content. Thus the wellness content of the database is functionally related to the "providing" step, the "placing in communication" step, and the "responding" step.

D. The BPAI's giving no patentable weight to the non-technical limitations applied a "technical effect" test, reading non-technical, business method limitations out of the claims, thereby allowing the rejection of business method patent claims using 35 U.S.C. § 103 rather than 35 U.S.C. § 101, circumventing this Court's holding in State Street Bank & Trust Co. v. Signature Financial Group, Inc.

The BPAI has all but said that technical limitations would be given patentable weight, for example steps which reconfigured the computer in some way [A8-9]. In *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 139 F.3d 1368 (Fed. Cir. 1998), this Court stated that "Since the 1952 Patent Act, business methods have been, and should have been, subject to the same legal requirements for patentability as applied to any other process or method" (*Id.* at 1375). In addition, the Court elaborated on how such claims should be analyzed for patentability, focusing on whether the invention produced a "useful, concrete, and tangible result" (*Id.*). The present invention clearly satisfies this standard by facilitating the storage of fitness data at the site where it is created, and then enabling the data to be retrieved remotely at the convenience of the individual user. The patentability of "business method" inventions was further reinforced in *AT&T Corp. v. Excel Communications Inc.*, 172 F.3d 1352 (Fed. Cir. 1999), in which the Court reaffirmed its earlier holding that a useful business method was patentable subject matter, stating that "the sea-changes in both law and technology stand as a testament to the ability of law to adapt to new and innovative concepts, while remaining true to its basic principles."

Thus, even business method limitations are not to be disregarded simply because they are related to business aspects. Applicant submits that the content of the database, the sponsorship of the portals, and the location of the portals are claim limitations which are functionally related to each other.

Signature Financial Group's U.S. Patent No. 5,193,056 was at issue in *State Street*. Claim 1 of that patent is reproduced below. Claim limitations which would be given no patentable weight in an analogous method claim, should the BPAI prevail over Appellant Curry, are bracketed and italicized.

1. A data processing system for managing a financial services configuration of a portfolio established as a partnership, each partner being one of a plurality of funds, comprising:
 - (a) computer processor means for processing data;
 - (b) storage means for storing data on a storage medium;
 - (c) first means for initializing the storage medium;
 - (d) second means for processing data [*regarding assets in the portfolio and each of the funds from a previous day and data regarding increases or decreases in each of the funds, assets and for allocating the percentage share that each fund holds in the portfolio*];
 - (e) third means for processing data [*regarding daily incremental income, expenses, and net realized gain or loss for the portfolio and for allocating such data among each fund*];
 - (f) fourth means for processing data [*regarding daily net unrealized gain or loss for the portfolio and for allocating such data among each fund*]; and
 - (g) fifth means for processing data [*regarding aggregate year-end income, expenses, and capital gain or loss for the portfolio and each of the funds*].

What remains of this claim could be rejected under 35 U.S.C. § 102 as not novel, or under 35 U.S.C. § 103 as obvious over ancient prior art, if applying the

BPAI's reasoning as against Appellant Curry. The Signature Financial claimed computer hardware and networking software are not described as novel, and the database contents need be given no more patentable weight than music or literature using the BPAI's analysis [A8]. Signature Financial Claim 1 could then be rejected by the PTO. However, if the *business utility* is considered, as now required by this Court, and the non-technical, business related limitations which make the invention possible are given patentable weight, then Signature Financial Claim 1 and related method claims remain valid.

E. Non-technical, business related limitations should be given patentable weight.

The fitness database contents, the fitness center portal locations, and the fitness center portal sponsorship are all limiting limitations, and would be so considered during litigation. In but one example, what would result from bringing suit for patent infringement under the appealed claims, against a library having an on-line catalog, where the patent claim method step limitations required the kiosk to be located in a fitness center, be sponsored by a fitness center, and allow for entering workout data to be viewed elsewhere?

The practical utility of the steps recited in the method claims is commercial in nature, not technical. Whether the claim limitations are functionally involved in the method claim steps may be tested by interchanging them with other

"nonfunctional descriptive material" for example, the music or literature suggested by the BPAI [A8]. Appellant believes the practical utility of his fitness tracking system would be significantly impaired if the allegedly "nonfunctional descriptive material" were so changed.

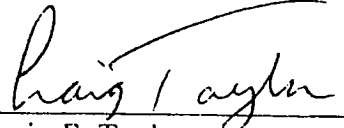
If invention elements which lead to claim limitations enhance this commercial utility, they should be given patentable weight, just as technical limitations which enhance technical utility should be given patentable weight. If business method claims are to be allowed, then business method limitations must be as well. To hold otherwise allows the PTO to reject claims such as Signature Financial Claim 1 by applying a blue pencil to non-technical limitations, then applying 35 U.S.C. § 103, rather than engage in litigation over statutory subject matter under 35 U.S.C. § 101.

CONCLUSION AND STATEMENT OF RELIEF SOUGHT

This court held "the burden of establishing the *absence* of a novel, nonobvious *functional relationship* rests with the PTO. If examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is *entitled* to grant of the patent" *In re Lowry* 32 F.3d 1579, 1584 (Fed. Cir. 1994) (emphasis added).

The present application, filed over five years ago, provided methods for entering fitness data at a fitness center and viewing them at home. The invention also provided fitness centers financial reasons synergistically related to the content, location, use, and properties of the kiosks to provide kiosks for their members. The prior art provided by the Examiner did not teach this. This has further resulted in a curtailment of patent rights to the Appellant and is an improper application of the law. A failure to identify and apply specific prior art should lead to allowance rather than Final Rejections of these claims.

Appellant requests that the Court either reverse the rejections of claims 81, 82, 85 and 93 under 35 U.S.C. § 103, or order the BPAI panel to reverse these rejections.

 Dec. 2, 2005
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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

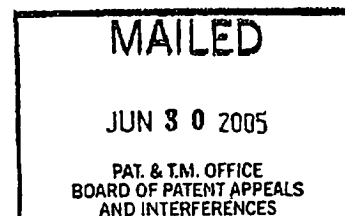
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JAMES PRESCOTT CURRY

Appeal No. 2005-0509
Application No. 09/449,237

ON BRIEF



Before BARRETT, BARRY, and MACDONALD, *Administrative Patent Judges*.

MACDONALD, *Administrative Patent Judge*.

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DECISION ON APPEAL

INTELLECTUAL PROPERTY DEPARTMENT

This is a decision on appeal from the final rejection of claims 81-93 and 95-97. Claims 1-80 and 94 have been canceled.

Invention

Appellant's invention relates to a method and system that allows users to custom design interactive fitness, diet, and rehabilitation programs and purchase goods. The system and method includes at least one portal, a distributed network, and a controller or server. The portals are distributed to sponsors to provide distributed access to the controller. For example, a sponsored portal could be a kiosk placed in a health club, fitness center or shopping mall. An

authorized non-sponsored portal could be an authorized user's home computer. In operation, when a user connects to the controller, the controller initiates a validation sequence. The controller seamlessly accesses a record system or a database to identify the portal and the user. When the portal and the user are identified, the controller assigns an access code. Preferably, the access code defines the user's access rights that determine the level of services and discounts offered to the user. While the access code is being assigned, the controller may transparently access a payment database or a payment controller that retains records of user accounts receivable. If the user is delinquent, the controller can prompt the user to tender payment. Payment may then be tendered, for example, through credit cards, electronic fund transfer, debit cards, digital cash, vending systems, or other known electronic commerce methods. Appellant's specification at page 2, lines 2-18.

Claim 81 is representative of the claimed invention and is reproduced as follows:

81. A method of providing wellness-related services, including at least one of wellness, health, or fitness services through a publicly accessible distributed network to authorized users using authorized portals, comprising:

providing an online site that enables wellness-related databases to be accessed from at least one of a sponsored and a non-sponsored portal;

placing in communication at least one of a sponsored and non-sponsored portal to the online site through the publicly accessible distributed network wherein the publicly accessible distributed network includes the Internet, wherein the sponsored portal is at least in part sponsored by and located at, a fitness center, and wherein at least one of the non-sponsored portals accesses the on-line site through the Internet;

receiving a request at the online site requesting access to the wellness-related databases;

processing the request at the online site to determine whether the portal was sponsored and whether the request was received from an authorized user; and

responding to the request based in part on whether the portal was sponsored and whether the user is authorized.

References

The references relied on by the Examiner are as follows:

Baker et al. (Baker)	5,678,041	Oct. 14, 1997
Roth	5,890,997	Apr. 6, 1999
Szabo	5,954,640	Sep. 21, 1999

Rejections At Issue

Claims 81 and 93 stand rejected under 35 U.S.C. § 103 as being obvious over Baker.

Claims 82-87, 90, and 95-97 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Baker and Szabo.

Claims 88, 89, 91 and 92 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Baker and Szabo and Roth.

Throughout our opinion, we make references to the Appellant's briefs, and to the Examiner's Answer for the respective details thereof.¹

¹ Appellant filed an appeal brief on October 8, 2003. Appellant filed a reply brief on June 4, 2004. The Examiner mailed an Examiner's Answer on April 2, 2004.

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellant and the Examiner, for the reasons stated *infra*, we affirm the Examiner's rejection of claims 81, 82, 85, and 93 under 35 U.S.C. § 103, and we reverse the Examiner's rejection of claims 83-84, 86-92, and 95-97 under 35 U.S.C. § 103.

Only those arguments actually made by Appellant have been considered in this decision. Arguments that Appellant could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by Appellant [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)].

Appellant has indicated that for purposes of this appeal, the claims stand or fall together in twelve groupings. See page 5 of the brief. However, Appellant does not argue each group of claims separately and explain why the claims of each group are believed to be separately patentable. Rather, Appellant has repeated the same few arguments for multiple groups. See pages 6-18 of the brief and pages 2-4 of the reply brief. Appellant has not met the requirements of 37 CFR § 1.192 (c)(7) (July 1, 2002) as amended at 62 Fed. Reg. 53169 (October 10, 1997), which was controlling at the time of Appellant's filing of the brief. 37 CFR § 1.192 (c)(7) states:

Grouping of claims. For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the

group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

We will, thereby, consider Appellant's claims as standing or falling together in five groups based on the distinct rejections and arguments presented by Appellant, and we will treat:

Claim 81 as a representative claim of Group I (claims 81 and 93);

Claim 82 as a representative claim of Group II (claim 82);

Claim 85 as a representative claim of Group III (claim 85);

Claim 86 as a representative claim of Group IV (claims 83-84, 86-87, 90, and 95-97), and

Claim 88 as a representative claim of Group V (claims 88-89 and 91-92).

If the brief fails to meet either requirement, the Board is free to select a single claim from each group and to decide the appeal of that rejection based solely on the selected representative claim. *In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002). *See also In re Watts*, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004).

I. Whether the Rejection of Claims 81 and 93 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as set forth in claims 81 and 93. Accordingly, we affirm.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellant. *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. *See also Piasecki*, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of

record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to independent claim 81, Appellant argues at pages 6-11 of the brief, that the Examiner has erred in finding 1) the type of data in the database is nonfunctional descriptive material, 2) the physical location (a fitness center) where part of the method is performed is merely a field of use limitation, and 3) the sponsorship status of the portal is nonfunctional descriptive material. We note that Appellant also believes that the Examiner has read these limitations out of the claims and may believe that these limitations are merely business method limitations. On these two points we find nothing in the record before us to support Appellant's business method contention and rather than reading the limitations out of the claims, we find that the Examiner has addressed each of the three limitations listed above.

As to the type of data in the database, we find the Examiner's position to be the better. We find that the "wellness-related" data in the databases and communicated on the distributed network does not functionally change either the data storage system or communication system used in the method of claim 81. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. *In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004). *Cf. In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not

functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

Common situations involving nonfunctional descriptive material are:

- a computer-readable storage medium that differs from the prior art solely with respect to nonfunctional descriptive material, such as music or a literary work, encoded on the medium,
- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or
- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

Thus, if the prior art suggests storing a song on a disk, merely choosing a particular song to store on the disk would be presumed to be well within the level of ordinary skill in the art at the time the invention was made. The difference between the prior art and the claimed invention is simply a rearrangement of nonfunctional descriptive material.

As to the physical location (in a fitness center) being merely a field of use limitation, again we find the Examiner's position to be the better. We find that the claimed fitness center does not differ structurally from the school taught by Baker (column 1). We find that they differ solely based on their intended use. Appellant himself reinforces this in the specification at page 2, where he discloses the portal could be in either a fitness center or a shopping mall. Clearly, the fitness center and shopping mall are the same structurally and differ

only as to their intended uses. Statements of intended use do not serve to distinguish structure over the prior art. *See In re Pearson*, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974); *In re Yanush*, 477 F.2d 958, 959, 177 USPQ 705, 706 (CCPA 1973); *In re Casey*, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967).

As to the sponsorship status of the portal, again we find the Examiner's position to be the better. Appellant at page 8 of the specification states that sponsorship is related to location data including portal addresses and at page 3 states that users' access rights are adjusted according to their location. That is, portal addresses control access rights. As the Examiner has pointed out in the rejection, Baker teaches this at column 4. We find that Baker clearly teaches differing access rights based on location data including portal addresses. We find that the further labeling of a portal as sponsored or unsponsored does nothing to change the structure or functionality of the portal. We concur with the Examiner that this is nonfunctional descriptive material.

Finally, we note that while Baker teaches "authorized portals" (referred to as users or user terminals), Baker does not appear to have "authorized users" within the meaning of claim 81. However, authorization of individual users (as opposed to terminals) is such a pervasive concept in the art that we presume this is why Appellant did not argue it. Regardless, we deem this argument to be waived by Appellant as Appellant chose not to make the argument.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103.

II. *Whether the Rejection of Claim 82 Under 35 U.S.C. § 103 is proper?*

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as set forth in claim 82. Accordingly, we affirm.

With respect to dependent claim 82, Appellant argues at page 14 of the brief, that neither reference teaches "'fitness related data" as the data entered and accessed in the database. As we have discussed above with respect to claim 81, the type of data does not functionally change either the data storage system or communication system used in the method.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103.

III. *Whether the Rejection of Claim 85 Under 35 U.S.C. § 103 is proper?*

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as set forth in claim 85. Accordingly, we affirm.

With respect to independent claim 85, Appellant repeats the arguments of claim 81 at pages 11-13 of the brief. We find these arguments unpersuasive for the reasons already discussed above with respect to claim 81.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103.

IV. Whether the Rejection of Claims 83-84, 86-87, 90, and 95-97 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 83-84, 86-87, 90, and 95-97. Accordingly, we reverse.

With respect to independent claim 86, Appellant argues at page 13 of the brief, "Szabo discusses adaptive models for users already in groups, not automatically assigning users to groups based on user attributes." We have reviewed the references, and we agree with Appellant. We find that the second assigning step of claim 86 is not reasonably taught by the references. Therefore, the Examiner has not met the initial burden of establishing a *prima facie* case of obviousness and we will not sustain the Examiner's rejection under 35 U.S.C. § 103.

V. Whether the Rejection of Claims 88-89 and 91-92 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 88-89 and 91-92. Accordingly, we reverse.

With respect to dependent claims 88-89 and 91-92, we note that the Examiner has relied on the Roth reference solely to teach "workout guidelines

and advise" (answer at page 10). The Roth reference in combination with the Baker and Szabo patents fails to cure the deficiencies of Baker and Szabo noted above with respect to claim 86. Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103 for the same reasons as set forth above.

Conclusion

In view of the foregoing discussion, we have sustained the rejection under 35 U.S.C. § 103 of claims 81, 82, 85, and 93, and we have not sustained the rejection under 35 U.S.C. § 103 of claims 83-84, 86-92, and 95-97.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

Lee E. Barrett
LEE E. BARRETT
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

ALLEN R. MACDONALD
Administrative Patent Judge

**BOARD OF PATENT
APPEALS AND
INTERFERENCES**

ARM/lbg

Appeal No. 2005-0509
Application No. 09/449,237

Page 13

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IN RE JAMES PRESCOTT CURRY

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COUNTY OF NEW YORK)

NELSON CABAN, being duly sworn according to law and being over the age of 18, upon my oath depose and say that
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I served the within Brief for Appellant in the above captioned matter upon:

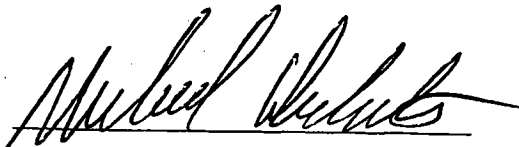
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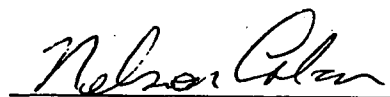
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Notary Public, State of New York
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Qualified in Queens County
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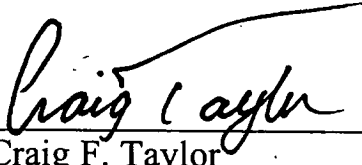


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CERTIFICATE OF COMPLIANCE

I, Craig F. Taylor, hereby certify that the total word count in the brief is words in Times New Roman, 14 pt. type And has 5, 762 words and that it has complied with the Federal Rules of Civil Procedure, Rule 32(a)(7).

Respectfully Submitted,

A handwritten signature in cursive script, reading "Craig F. Taylor", is written over a horizontal line.

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